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Remarks

I. Status of claims

Claims 1-16 and 20-29 are pending.

The Examiner has indicated that claims 1-6, 16, 20, and 22-29 have been allowed.

In a telephone conference with the undersigned on January 30, 2006, the Examiner stated that claims 10-15, which depend from independent claim 1, also have been allowed.

II. Claim rejections – 35 U.S.C. § 103(a)

The Examiner has rejected claims 7-9 and 21 under 35 U.S.C. § 103(a) over Epstein (U.S. 6,601,172) in view of Zank (U.S. 6,307,955).

For the reasons explained in detail below, neither of the cited references teaches or suggests converting a base image that includes an image of a handwritten signature into a marked image having a visual appearance that resembles the base image and contains a graphical encoding of the signed message, as recited in claims 7-9 and 21. Therefore, no combination of the cited references possibly could render the invention recited in claims 7-9 and 21 obvious. In addition, the Examiner has not provided a proper explanation for combining the cited prior art to arrive at the invention recited in claims 7-9 and 21. Instead, it appears that the Examiner impermissibly has used applicants' disclosure as a blueprint for piecing together elements from incompatible sources in a manner that reconstructs the invention recited in claims 7-9 and 21 only with the benefit of hindsight. As a result, the Examiner has failed to establish a proper *prima facie* case of obviousness and the rejection of claims 7-9 and 21 should be withdrawn.

In her rejection of independent claim 7, the Examiner has stated that:

> Epstein teaches generating a corroborative signed message
> from information to be encoded (col. 2, lines 24-60). Not
> explicitly disclosed by Epstein is converting a base image that
> includes an image of a handwritten signature into a marked
> image having a visual appearance that resembles the base
> image and contains a graphical encoding of the signed message.
> However, Zank et al. teach a handwritten signature that
> preserves all of the features/elements of the biometric
> signature, for example by having time related information
> encoded into the signature. Furthermore, this signature can also

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be added to a document for authentication purposes. Therefore it would have been obvious to a person in the art at the time the invention was made to modify the method disclosed in Epstein to include converting a base image that includes an image of a handwritten signature into a marked image having a visual appearance that resembles the base image and contains a graphical encoding of the signed message. This modification would have been obvious because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Zank et al. in col. 5, lines 43-62 and col. 7, lines 51-59.

Thus, the Examiner has indicated that Epstein teaches the feature of claim 7 relating to generating a corroborative signed message but fails to teach or suggest anything about "converting a base image that includes an image of a handwritten signature into a marked image having a visual appearance that resembles the base image and contains a graphical encoding of the signed message." To make-up for this failure of Epstein's teachings, the Examiner has relied on Zank's alleged teachings of "a handwritten signature that preserves all of the features/elements of the biometric signature" and "can also be added to a document for authentication purposes."

On its face, the Examiner's rejection of claim 7 does not establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103 because it does not show that the combination of Epstein and Zank teaches or suggests all the claim limitations. In particular, since the Examiner has acknowledged that Epstein fails to teach or suggest "converting a base image that includes an image of a handwritten signature into a marked image having a visual appearance that resembles the base image and contains a graphical encoding of the signed message," it is incumbent on the Examiner to show that Zank teaches or suggests this feature (see, e.g., MPEP § 706.02(j)). The Examiner's statements that Zank teaches "a handwritten signature that preserves all of the features/elements of the biometric signature" and "can also be added to a document for authentication purposes" does not constitute a showing that Zank teaches or suggests "converting a base image that includes an image of a handwritten signature into a marked image having a visual appearance that resembles the base image and contains a graphical encoding of the signed message."

For at least this reason, the Examiner's rejection of independent claim 7 under 35 U.S.C. § 103(a) over Epstein in view of Zank should be withdrawn.

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The inability of the Examiner to point to any disclosure in Zank that teaches or suggests "converting a base image that includes an image of a handwritten signature into a marked image having a visual appearance that resembles the base image and contains a graphical encoding of the signed message" is not surprising because Zank simply does not teach this feature of claim 7.

In accordance with Zank's teachings an electronic signature is captured from a handwritten signature that is entered on a pen tablet. The electronic signature consists of data that is derived from the handwritten signature, including sets of sequentially ordered coordinates as well as other data that preserves various biometric properties. The captured electronic signature data, however, is not an image having a visual appearance that resembles the base image.

Zank also teaches that "receipts of the document and the signature are printed for delivery to the signer" (col. 7, lines 19-20). The receipts consist of 8-40 characters that serve as a unique representation of both the document and the signature (see col. 7, lines 21-24). The 8-40 character receipts clearly do not have visual appearances that resemble the corresponding handwritten signatures from which they were derived.

With reference to FIG. 3, Zank describes a process for retrieving a signed document based on both the original document and the original signature (see col. 7, line 61 – col. 8, line 20). The resulting unlocked signed document, however, corresponds exactly to the original signed document; it does not correspond to a marked image that contains a graphical encoding of a signed message, as recited in claim 7.

In FIG. 4, Zank shows an authentication screen 70 "that permits at least two signatures to be compared on a computer screen side-by-side or over and under" (col. 8, lines 29-31). Zank, however, does not even hint that either of the illustrated signatures contains a graphical encoding of a signed message, as recited in claim 7.

The processes by which Zank's signature management program generates and uses the electronic signature simply does not involve "converting a base image that includes an image of a handwritten signature into a marked image having a visual appearance that resembles the base image and contains a graphical encoding of the signed message." Thus, neither Epstein nor Zank teaches or suggests this feature of claim 7. Therefore, no permissible combination of Epstein and Zank possible could teach or suggest this feature of claim 7 and the Examiner's rejection of independent claim 7 should be withdrawn.

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The Examiner has concluded her discussion of Zank with the statement that her proposed modification of Epstein's revision authentication method based on Zank's teachings would have been obvious "because a person having ordinary skill in the art, at the time the invention was made, would have been motivated to do so since it is suggested by Zank et al. in col. 5, lines 43-62 and col. 7, lines 51-59." This conclusion, however, is not supported by Zank's disclosure. In col. 5, lines 43-62, Zank merely describes the coordinated operation of a pen tablet 24 and a clock circuit 29. In col. 7, lines 51-59, merely indicates that the electronic signature file includes biometric properties that can be examined at a later date for authenticity by a forensic document examiner.

The Examiner is asked to point to specific locations in the cited references that provide the requisite motivation to combine the references as proposed by the Examiner and that provide the requisite factual basis from which one of ordinary skill in the art at the time the invention was made could have a reasonable basis for believing that such a combination would be successful (see MPEP § 706.02(j)). In this process, the Examiner is reminded that she is not permitted to engage in hindsight reconstruction of the claimed invention, using applicants' disclosure as a blueprint for piecing together prior art to defeat patentability. Without a proper explanation for combining the cited prior art, the Examiner has failed to establish a proper *prima facie* case of obviousness and the rejection of independent claim 7 should be withdrawn.

For the reasons explained above, the Examiner's rejection of independent claim 7 under 35 U.S.C. § 103(a) over Epstein in view of Zank should be withdrawn.

Each of claims 8, 9, and 21 incorporates the features of independent claim 7 and therefore is patentable over Epstein, Kato, and Iizuka for at least the same reasons explained above.

III.   Conclusion

For the reasons explained above, all of the pending claims are now in condition for allowance and should be allowed.

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Respectfully submitted,

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